



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte PAUL F. MANLEY

Application No. 10/784,707

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on February 10, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On February 17, 2003, the examiner entered a Final rejection of claims 1-22 under 35 U.S.C. § 103(a) as unpatentable over Nakanish, Food Packaging, and Sigeo (JP 55034966 A), in view of Cone (U.S. Patent No. 5,229,149), Waters (U.S. Patent No. 6,376,000), MacPherson (U.S. Patent No. 5,017,394), Stewart (U.S.

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Patent No. 6,616,958) and the applicant's admission of the prior art.

On September 20, 2005, appellant filed an Appeal Brief. In response to appellant's Brief, the examiner mailed an Examiner's Answer on November 2, 2005. The examiner states on page 2, section (6) of the Answer that "appellant's statement of the grounds of rejection to be reviewed on appeal is correct." However, a review of the Answer mailed on November 2, 2005 reveals that the examiner has rejected the claims as follows:

(a) claims 1-4, 7-19, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi, Food Packaging, Shigeo, in view of Cone, Waters and applicant's admission of the prior art;

(b) claims 5, 6 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi, Food Packaging, and Shigeo, in view of Cone, Waters and applicant's admission of the prior art, further in view of Stewart.

It is not clear from the Examiner's Answer whether or not the examiner has entered a new ground of rejection, or why the examiner has chosen not to include the MacPherson patent in his rejection of claims, nor list this particular reference under the

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heading "Evidence Relied Upon."

According to MPEP § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

(1) clarify for the record the rejections of claims on appeal, and if entering a new ground of rejection, to

(2) reopen prosecution to address the new ground of rejection,

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(3) to obtain approval from a TC Director or appropriate designee; and

(4) for such further action as may be appropriate.

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By: 

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DMS/clm